

Remarks

The July 26, 2006 Official Action and the references cited therein have been carefully reviewed. In view of the following remarks, favorable reconsideration and allowance of this application are respectfully requested.

At the outset, it is noted that a shortened statutory response period of three (3) months was set in the July 26, 2006 Official Action. Therefore, the initial due date for response was October 26, 2006. A petition for a one (1) month extension of the response period is presented with this response, which is being filed within the one month extension period.

The Examiner has rejected claims 1-11, 13-17, 20-22, 25-27, 29, 30, 33-38, 41, 42, 47-49, and 51-59 for allegedly failing to satisfy the enablement requirement of 35 U.S.C. §112, first paragraph on two separate grounds.

Claims 25-27, 29, 30, 48, 49, and 57-59 have also been rejected under 35 U.S.C. §102(b) as allegedly anticipated by Dinsmore et al. (Theriogenology (1998) 19:145-151). Applicants continue to respectfully disagree with the Examiner for the reasons of record. However, in the sole interest of expediting prosecution of the instant application, Applicants have cancelled claims 25-27, 29, 30, 48, 49, and 57-59, thereby rendering the instant rejection moot.

The foregoing rejections constitute all of the grounds set forth in the July 26, 2006 Official Action for refusing the present application.

In accordance with the instant amendment, Applicants have amended claims 1, 20, 33, 35, 37, and 47 to indicate that the media comprises leukemia inhibitory factor (LIF) and that the embryonic stem cells are mammalian. Support for these amendments can be found in the claims as previously presented and throughout the specification including, for example, at page 10, lines 21-27.

No new matter has been introduced into this

application by reason of any of the amendments presented herewith.

In view of the reasons set forth in this response, Applicants respectfully submit that the 35 U.S.C. §112, first paragraph rejections of claims 1-11, 13-17, 20-22, 25-27, 29, 30, 33-38, 41, 42, 47-49, and 51-59 and the 35 U.S.C. §102(b) rejection of claims 25-27, 29, 30, 48, 49, and 57-59, as set forth in the July 26, 2006 Official Action, cannot be maintained. These grounds of rejection are, therefore, respectfully traversed.

CLAIMS 1-11, 13-17, 20-22, 25-27, 29, 30, 33-38, 41, 42, 47-49, AND 51-59 FULLY SATISFY THE ENABLEMENT REQUIREMENT OF 35 U.S.C. §112, FIRST PARAGRAPH

The Examiner has rejected claims 1-11, 13-17, 20-22, 25-27, 29, 30, 33-38, 41, 42, 47-49, and 51-59 for allegedly failing to satisfy the enablement requirement of 35 U.S.C. §112, first paragraph on two separate grounds. First, it is the Examiner's position that while the specification is "enabling for a mammalian primitive neural stem cell and a method of making and using a primitive neural stem cell ... produced from a culture of mammalian ES cells," the specification allegedly fails to fully enable "a neural stem cell, method of making or method of using neural stem cell wherein the cell is produced from ... any animal." Second, the Examiner has rejected claims 1-11, 20-22, 29, 33-38, 41, 42, 47, and 56 because the specification allegedly does not enable a skilled artisan to perform the instantly claimed methods with culture medium which lacks LIF.

Applicants respectfully disagree with the Examiner's positions for the reasons already of record. However, in the sole interest of expediting prosecution of the instant application, Applicants have amended the instantly rejected claims to recite that the embryonic stem cells are mammalian

and that the culture media comprises LIF.

In view of the foregoing, Applicants submit that the rejection of the claims under §112 first paragraph for inadequate enablement has been overcome. Withdrawal of the rejections is respectfully requested.

STATEMENT OF SUBSTANCE OF INTERVIEW

In an Interview Summary Form provided with the July 26, 2006 Official Action, Applicants were given the time period for responding to the Official Action to file a Statement of Substance of Interview. This Statement of Substance of Interview is being submitted in accordance with §713.04 of the Manual of Patent Examining Procedure to make of record a telephone interview held between Examiner Daniel M. Sullivan, Kate Rigaut (Reg. No. 43,047), co-inventor Vincent Tropepe, and the undersigned on or about July 11, 2006.

The Examiner contacted the undersigned on or about July 7, 2006 regarding a proposed Examiner's Amendment to cancel claims 25-27, 29, 30, 48, 49, and 57-59. The undersigned requested an interview with the Examiner which was held on or about July 11, 2006 for the purpose of discussing the 35 U.S.C. §102(b) rejection of claims 25-27, 29, 30, 48, 49, and 57-59 based on Dinsmore et al. Examiner Sullivan indicated that despite having previously determined that the product claims encompassed allowable subject matter, he was maintaining the 35 U.S.C. §102(b) rejection based on Dinsmore et al. absent factual evidence regarding certain cellular characteristics of the cells obtained by Dinsmore et al. Applicants respectfully declined the proposed Examiner's Amendment.

This Statement of Substance of Interview is being filed with the response to the Official Action containing the Interview Summary Form.

CONCLUSION

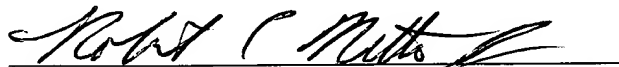
It is respectfully requested that the amendments presented herewith be entered in this application, since the amendments are primarily formal, rather than substantive in nature. This amendment is believed to clearly place the pending claims in condition for allowance. In any event, the claims as presently amended are believed to eliminate certain issues and better define other issues which would be raised on appeal, should an appeal be necessary in this case.

In view of the amendments presented herewith, and the foregoing remarks, it is respectfully urged that the rejections set forth in the July 26, 2006 Official Action be withdrawn and that this application be passed to issue.

In the event the Examiner is not persuaded as to the allowability of any claim, and it appears that any outstanding issues may be resolved through a telephone interview, the Examiner is requested to telephone the undersigned at the phone number given below.

Respectfully submitted,
DANN, DORFMAN, HERRELL AND SKILLMAN
A Professional Corporation

By



Robert C. Netter, Jr., Ph.D.
PTO Registration No. 56,422

Telephone: (215) 563-4100